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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,210	07/28/2003	Daniel G. Brady	27556	5311
7590		11/02/2007		
Peter J. Gluck Advanced Medical Optics, Inc. 1700 E. St. Andrew Place Santa Ana, CA 92705			EXAMINER PREBILIC, PAUL B	
			ART UNIT 3774	PAPER NUMBER
			MAIL DATE 11/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/629,210

Applicant(s)

BRADY ET AL.

Examiner

Paul B. Prebilio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5,7,8,12-14,33,36,37,41,42,45-47 and 52-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5,7,8,12-14,33,36,37,41,42,45-47 and 52-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 3, 5, 7, 8, 12-14, 33, 36, 37, 41, 42, 45-47, and 52-55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The diopter range claimed lacks original support. The Applicant failed to particularly point out where there was support in the Faklis patent (US 5,589,982) such that appears to constitute new matter. In fact, a search on the terms "diopter", "dioptic" and "diopters" was performed on the text of this patent and no such terms were found.

Specification

The amendment filed September 4, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment adding a diopter range into the specification on page 8 introduces new matter into the disclosure because it lacks original support.

Applicant is required to cancel the new matter in the reply to this Office Action.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 13 and 37 now apparently contradict base claim 45 since claim 45 precludes multifocal lenses.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 3, 7, 8, 13, 41, 42, 45, 47, 54 and 55 are rejected under 35 U.S.C. 103(a) as obvious over Lang (US 6,231,603) in view of Cohen (US 5,121,980) or Futhey et al (US 5,229,797). Lang meets the claim language where the primary lens as claimed is posterior lens (72) of Lang, and the supplemental lens as claimed is IOL lens (110); see Figure 5 and column 6, line 32 et seq. Note that the IOL lens can be diffractive and that this language is written as the alternative, thus clearly suggesting that an wholly refractive or diffractive lens can be utilized; see column 4, lines 24-34 and column 1, lines 50-62. Furthermore, since the IOL lens is monofocal or multifocal it necessarily must have an optical power of either positive or negative. Figure 3 shows that the IOL lens have both positive diopter (positive power) regions and negative diopter (negative power) regions. However, Lang fails to disclose the diopter power of

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the lenses thereof. However, Cohen (see column 4, lines 33-35) and Futhey (see column 2, line 51 et seq.) both teach that it was known to the art to make lenses within the claimed diopter range. Therefore, it is the Examiner's position that the claimed diopter range is clearly obvious over Lang in view of Cohen or Futhey due to the structural similarity and function in the same art.

One could argue that the present claim language is not met because the power of the posterior lens is not specified. However, the Examiner asserts that the lens system of Lang would inherently be designed to correct the vision of the patient so that it would not be excessive or insufficient. Moreover, it would have been at least *prima facie* obvious to design the posterior lens of Lang to compensate for the negative power regions or positive power regions of the IOL so that the images created by the lens system would not be distorted.

With regard to claim 8 specifically, there is no special definition for operatively coupled. Since the lenses of Lang operate with light, they are considered to be operatively coupled to the extent required by the present claim language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang, Cohen, and Futhey as applied to claims 2-3, 7, 8, 13, 41, 42, 45, 47, 54 and

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55 above, and further in view of Cohen (US 5,117,306). Lang et al (US 6,231,603) fails to describe the details of the diffractive lens embodiment, and thus, fails to disclose utilizing echelettes and the diffraction profile. However, Cohen ('306) teaches that it was known to make diffractive intraocular lenses that are positively or negatively powered, that include echelettes, and that have first or multi-ordered profiles as claimed; see the figures and claims 19 and 22 thereof. Therefore, it is the Examiner's position that it would have been obvious to provide a diffractive supplemental lens having the characteristics disclosed by Cohen ('306) for the same reasons Cohen ('306) uses the same and in order to make a wide variety of lenses suitable for many different patients.

Regarding claim 33, the echelettes of the formula on column 1, line 35 are on the order of a wavelength (unspecified wavelength) of light in size.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lang, Cohen, and Futhey as applied to claims 2-3, 7, 8, 13, 41, 42, 45, 47, 54 and 55 above, and further in view of Patel (US 5,366,502). Lang et al (US 6,231,603) fails to use a toric diffractive lens as claimed. However, Patel teaches that such lenses were known; see column 8, lines 1-10. Therefore, it is the Examiner's position that it would have been obvious to use a toric lens in the Lang invention for the same reasons that Patel uses the same and in order to aid a patient with an astigmatism (via a toric lens).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lang, Cohen, and Futhey as applied to claims 1-3, 7, 8, 13, 41, 42, 45, 47, 54 and 55 above, and further in view of Portney (US 6,197,058) or Nordan et al (US 2003/0097176).

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Lang fails to teach the thickness of the diffractive supplemental lens as claimed.

However, Portney (see column 7, lines 59-62) and Nordan (see abstract) both teach that lens thicknesses of less than 250 microns were known. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to make the Lang supplemental lens less than 250 microns thick for the same reasons as the secondary references, and in order to make the lens insertable through a small incision.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lang, Cohen, and Futhey as applied to claims 2-3, 7, 8, 13, 41, 42, 45, 47, 54 and 55 above, and further in view of Copeland et al (US 2002/0042653). Lang fails to teach a blue blocker or tint feature as claimed. However, Copeland teaches that it was known to incorporate blue blocking or tint into intraocular lenses prior to the invention of the Applicants' invention; see the abstract. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to incorporate blue blocker or tint into the lens of Lang for the same reasons that Copeland does the same, that is, to achieve maximum visual acuity.

Claims 7, 8, 52, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang, Cohen, and Futhey as applied to claims 2-3, 7, 8, 13, 41, 42, 45, 47, 54 and 55 above, and further in view of Bandhauer et al (US 2004/0230300) or Miller (WO 03/000154).

As an alternative to the vaulted feature as claimed in claim 7, one could interpret the claim language as being limited to some feature connecting the two lenses in this fashion. However, since Bandhauer or Miller both teach that such connection features

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were known, it is the Examiner's position that it would have been obvious to connect the lenses of Lang in this fashion for ease of insertion and to provide a definite separation distance.

As an alternative interpretation of "operatively coupled" of claim 8 that requires a physical coupling of the two lenses, the Examiner sets forth the following rejection. Lang can be interpreted as not meeting the claim language because it could be said to not teach operatively coupling of the lenses in that they are not shown physically coupled. However, both Bandhauer and Miller teach that it was known to physically couple similar lens systems together; see Figure 11 of Bandhauer and see Figure 6 of Miller. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to couple the lenses of Lang together at the extreme ends thereof for the same reasons that the secondary references do the same or to set the distance from each other prior to accommodation.

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lang, Cohen, and Futhey as applied to claims 2-3, 7, 8, 13, 41, 42, 45, 47, 54 and 55 above, and further in view of Cohen (US 4,995,715). Lang fails to disclose the use of a blazed profile as claimed. However, Cohen ('715) teaches that it was known to utilize blazed profiles on diffractive lenses within the art; see column 6, lines 26-31. Therefore, it is the Examiner's position that it would have been obvious to utilize a blazed profile on the Lang diffractive lens for the same reasons that Cohen utilizes the same.

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Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/
Paul Prebilic
Primary Examiner
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